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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,597	12/12/2001	Robert Paul Cazier	10014023-1	3325

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EXAMINER

DOAN, DUYN MY

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,597

Applicant(s)

CAZIER ET AL.

Examiner

Duyen M Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/01</u> . | 6) <input type="checkbox"/> Other: _____ |

Detail Action

Claims 1-19 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (pat num 6839741) in view of Freed (us 2003/0055903).

As regarding claim 1, Tsai discloses a computer network (figure 1, network 16); a server communicating over said computer network and including an undelivered data storage (figure 1, server 20); and a sender computer communicating over said computer network (figure 1, sender 12); and wherein said e-mail system posts at least a portion of said bounced e-mail message to said undelivered data storage in said server and sends a notification e-mail message to an intended recipient of said bounced e-mail message, notifying said intended recipient of the existence of said bounced e-mail message and instructing said intended recipient as to how to retrieve said bounced e-mail message (col.3, line 1-24).

Tsai does not disclose electronic mail system compares a received e-mail message to previous e-mail messages sent from said sender computer and if a match occurs said e-mail system determines that said received e-mail message is a bounced e-mail message

Freed teaches electronic mail system compares a received e-mail message to previous e-mail messages sent from said sender computer and if a match occurs said e-mail system determines that said received e-mail message is a bounced e-mail message (page 3, paragraph 20, page 3-5, paragraph 25 (if there is a match between the received message and the previously store then determine that the message is duplicate)).

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the system Tsai with the teaching of Freed to have the server compare the received email message to previous email messages for the purpose of minimizing or perhaps even eliminating the duplicate messaging problem (see Freed page 2, paragraph 10).

As regarding claim 2, Tsai-Freed discloses computer network further comprises a plurality of inter-connected computer networks (see Tsai figure 1).

As regarding claim 3, Tsai-Freed discloses notification e-mail includes a server retrieval address comprising a hypertext markup language (HTML) address link identifying the location of said bounced e-mail message in said undelivered data storage (see Tsai col.3, line 25-33).

As regarding claim 4, Tsai-Freed discloses notification e-mail includes a server retrieval address comprising a uniform resource locator (URL) address identifying the location of said bounced e-mail message in said undelivered data storage (see Tsai col.4, line 11-26).

As regarding claim 5, Tsai discloses sender computer further comprising: a sent message storage storing previously sent e-mail messages (see figure 1, sender computer 12); a received message storage storing received e-mail messages (see figure 1, sender computer 12); a server retrieval address storage storing a server retrieval address of at least a portion of a bounced e-mail message posted to said server (see figure 1, sender computer 12); posts said at least a portion of said bounced e-mail message to said server, and sends said notification e-mail message to said intended recipient (col.3, line 1-24).

Tsai does not expressly disclose a comparison rule that governs how a bounce is detected; wherein said sender computer compares a received message to said previously sent e-mail messages according to said comparison rule, determines whether said received message was bounced.

Freed teaches a comparison rule that governs how a bounce is detected; wherein said sender computer compares a received message to said previously sent e-mail messages according to said comparison rule, determines whether said received message was bounced (page 3, paragraph 20, page 3-5, paragraph 25 (if there is a match between the received message and the previously store then determine that the

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message is duplicate)). The same motivation was utilized in claim 1, applied equally as well to claim 5.

As regarding claim 6, Tsai-Freed discloses sender computer receives a server retrieval address from said server after said at least a portion of said bounced e-mail message is posted to said server, with said server retrieval address being included in said notification e-mail message (see Tsai col.4, line 19-26).

As regarding claim 7, Tsai discloses server further comprising: a sent message storage storing previously sent e-mail messages (figure 1, server 20, with storage 22); a received message storage storing received e-mail messages (figure 1, server 20, with storage 22); sends said notification e-mail message to said intended recipient (col.4, line 11-26).

Tsai does not disclose a comparison rule that governs how a bounce is detected; wherein said server compares a received message to said previously sent messages according to said comparison rule, determines whether said received message was bounced.

Freed teaches a comparison rule that governs how a bounce is detected; wherein said server compares a received message to said previously sent messages according to said comparison rule, determines whether said received message was bounced (page 3, paragraph 20, page 3-5, paragraph 25 (if there is a match between the received message and the previously store then determine that the message is duplicate)). The same motivation was utilized in claim 1, applied equally as well to claim 7.

As regarding claim 8, Tsai-Freed discloses server transmits a server retrieval address to said intended recipient after a message bounce is detected, with said server retrieval address being included in said notification e-mail message (see Tsai col4, line 11-26).

Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (pat num 6839741) in view of Schneider (us 2002/0010745).

As regarding claim 9, Tsai disclose posting at least a portion of said bounced e-mail message to a server accessible to an intended recipient of said bounced e-mail message (col.3, line 1-24); and notifying said intended recipient of an availability of said at least a portion of said bounced e-mail message on said server (col.3, line 1-24); wherein said intended recipient accesses said server in order to obtain said at least a portion of said bounced e-mail message (col.3, line 1-24).

Tsai does not disclose determining if a received email message is a bounced email message.

Schneider teaches determining if a received email message is a bounced email message (see Schneider page 4, paragraph 47).

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Tsai with the teaching of Schneider to determining if a received email message is a bounced email message for the purpose of finding a solution in response to undeliverable messages (see Schneider page 2, paragraph 14).

As regarding claim 10, Tsai-Schneider discloses server performs the determining and notifying steps (see Tsai col.3, line 1-24).

As regarding claim 11, Tsai-Schneider discloses the preliminary steps of: said sender computer transmitting a generated e-mail message to said data server (figure, sender and server communication, col.3, line 45-67); and said data server relaying said generated e-mail message to said intended recipient (col.3, line 45-67); wherein said server performs the determining and notifying steps (see Tsai col.3, line 1-24).

As regarding claim 12, Tsai-Schneider discloses sender computer performs the determining and notifying steps (see Tsai figure 1, sender communicate with recipient through non internet email-18).

As regarding claim 13, Tsai-Schneider discloses sending a notification e-mail message to said intended recipient (see Tsai col.3, line 18-24).

As regarding claim 14, Tsai-Schneider discloses the notifying step further comprising embedding an HTML address link in a notification e-mail message (see Tsai col.3, line 25-33).

As regarding claim 15, Tsai -Schneider discloses the notifying step further comprising embedding a URL address in a notification e-mail message (see Tsai col.4, line 11-26).

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (us pat 6839741) and Schneider (us 2002/0010745) as applied to claim 9 above, and further in view of Freed (us 2003/0055903).

As regarding claim 16, Tsai and Schneider disclose every limitation of claim 9 above but the combination of Tsai and Schneider does not expressly disclose embedding a unique identifier in each outgoing e-mail message; comparing a previously sent message unique identifier to a received message unique identifier; and determining that said previously sent message was bounced if a match is found.

Freed teaches embedding a unique identifier in each outgoing e-mail message (page 2, paragraph 10); comparing a previously sent message unique identifier to a received message unique identifier (page 2, paragraph 10); and determining that said previously sent message was bounced if a match is found (page 3-4, paragraph 25).

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Tsai-Schneider with the teaching of Freed to have the server compare the received email message to previous email messages for the purpose of minimizing or perhaps even eliminating the duplicate messaging problem (see Freed page 2, paragraph 10).

As regarding claim 17, Tsai and Schneider disclose every limitation of claim 9 above but the combination of Tsai and Schneider does not expressly disclose comparing at least a portion of said previously sent message to a corresponding portion of a received e-mail message; and determining that said previously sent message was bounced if a match is found.

Freed teaches comparing at least a portion of said previously sent message to a corresponding portion of a received e-mail message (page 3-4, paragraph 25); and

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determining that said previously sent message was bounced if a match is found (page 3-4, paragraph 25).

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Tsai-Schneider with the teaching of Freed to have the server compare the received email message to previous email messages for the purpose of minimizing or perhaps even eliminating the duplicate messaging problem (see Freed page 2, paragraph 10).

As regarding claim 18, Tsai and Schneider disclose every limitation of claim 9 above but the combination of Tsai and Schneider does not expressly disclose maintaining a queue of outgoing messages with each message in said queue being stored for a predetermined time period; comparing at least a portion of said previously sent message to a corresponding portion of a received e-mail message; and determining that said previously sent message was bounced if a match is found.

Freed teaches maintaining a queue of outgoing messages with each message in said queue being stored for a predetermined time period (page3, paragraph 20); comparing at least a portion of said previously sent message to a corresponding portion of a received e-mail message (page 3-4, paragraph 25); and determining that said previously sent message was bounced if a match is found (page 3-4, paragraph 25).

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Tsai-Schneider with the teaching of Freed to have the server compare the received email message to previous email messages for the

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purpose of minimizing or perhaps even eliminating the duplicate messaging problem (see Freed page 2, paragraph 10).

As regarding claim 19, the limitation is similar to claim 18, therefore rejected for the same rationale as claim 18.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner
Duyen Doan
Art unit 2143

DD



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SUPERVISORY PATENT EXAMINER
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